

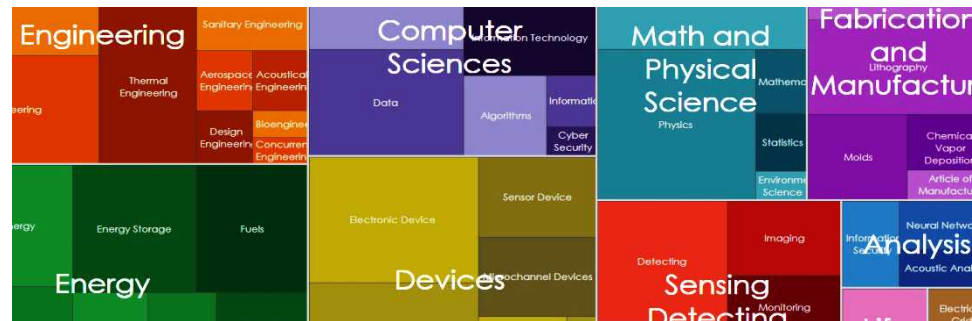
# IP Overview from Sandia National Labs' perspective

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Sandia National Labs

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*Exceptional service  
in the national interest*



Sandia National Laboratories is a multi-program laboratory managed and operated by Sandia Corporation, a wholly owned subsidiary of Lockheed Martin Corporation, for the U.S. Department of Energy's National Nuclear Security Administration under contract DE-AC04-94AL85000.

# Outline

## 1. Public disclosures



## 2. Copyrights and Sandia/DOE [copyright@sandia.gov](mailto:copyright@sandia.gov)

## 3. Patents and Sandia/DOE



1. Discuss inventions submitted as Technical Advances (TAs)
2. File & manage patent applications

## 4. Licensing Process

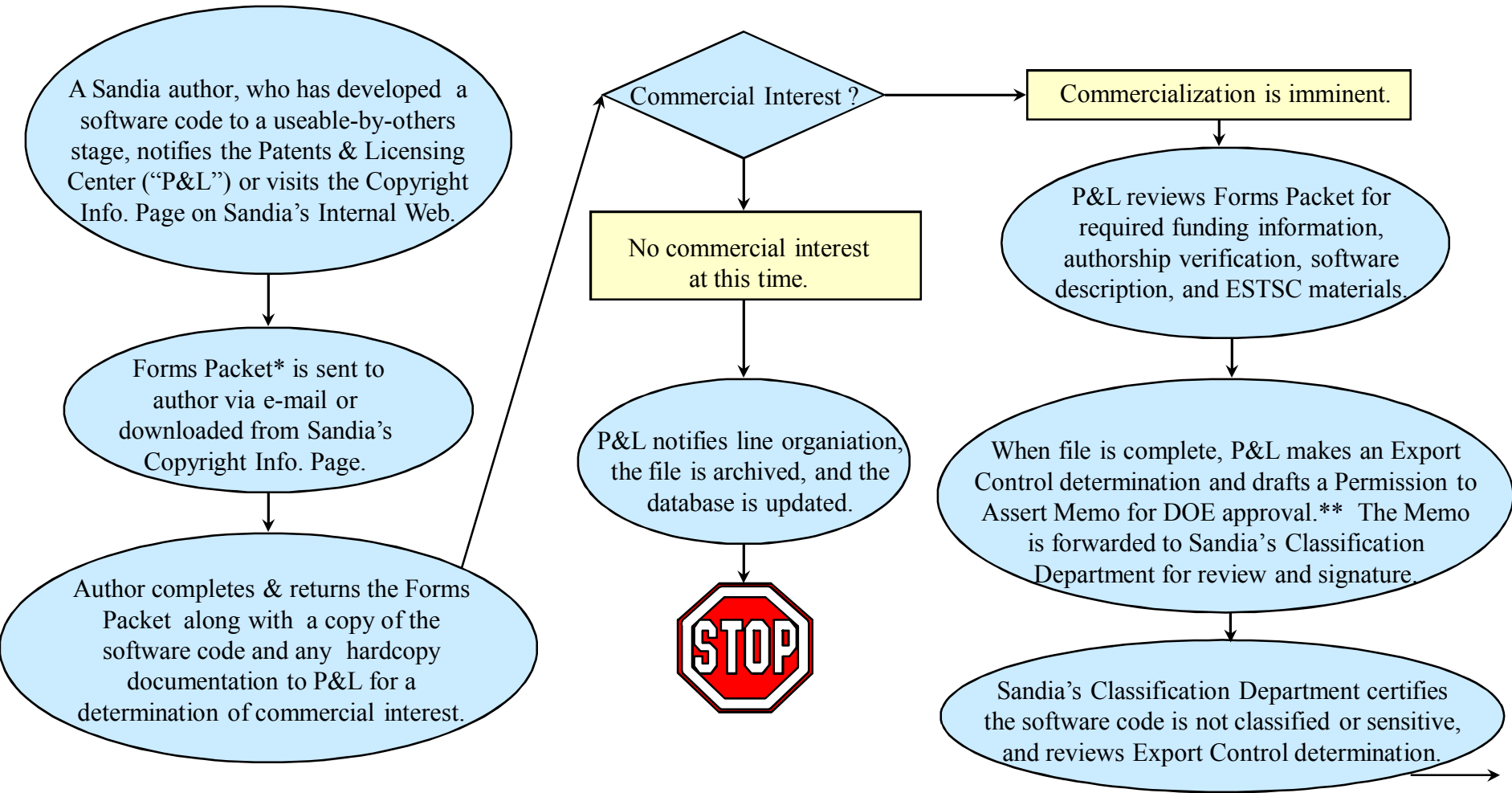
# Public Disclosures

- All Sandians signed the "Sandia Corporation Employee Proprietary Information and Innovation Agreement"
- Sandians agree to abide by reporting requirements and waive ownership of intellectual property to the Department of Energy.
  - Complete the **Review and Approval (R&A)** process prior to publication or public disclosure

# Copyright

- The **Department of Energy owns the rights** in copyrightable works created at Sandia because Sandia has assigned the rights to the Department of Energy via the M & O Contract.
- Before Sandia may distribute such works to external entities, Sandia must request permission from the Department of Energy. This process of requesting permission is termed "**copyright assertion.**"
- When DOE approves a request, it allows Sandia a **five-year window of time** to disseminate the materials as Sandia chooses. After the five-year period expires, Sandia may request an extension if the materials are still being disseminated.

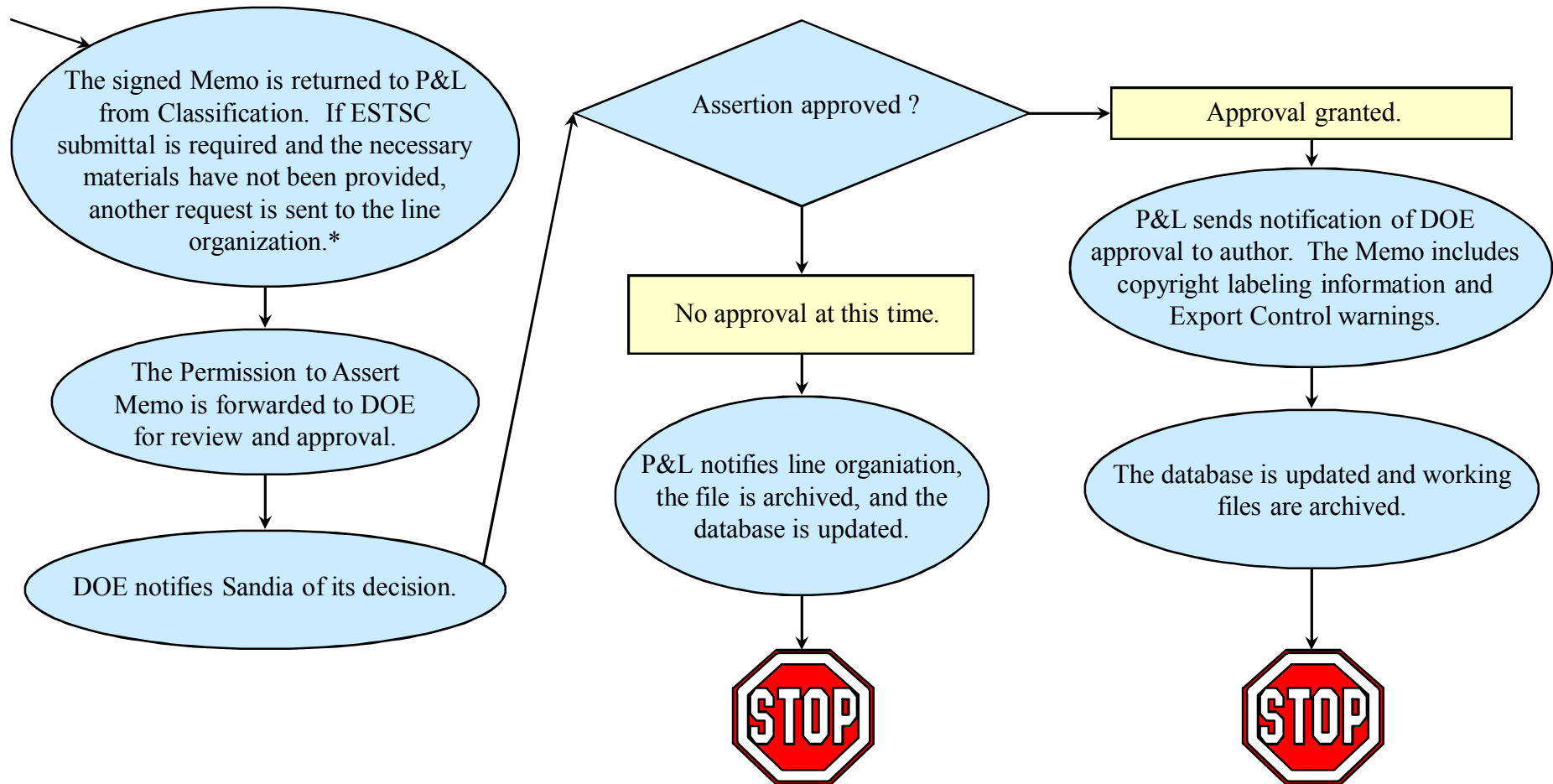
# Copyright Assertion Process



*\*Note: The Forms Packet includes an explanatory & instructional memo, a Combo. Software Questionnaire/ESTSC Abstract, a Sensitivity Review Form, an Authorship Memorandum Form, and ESTSC Submittal/Media Forms.*

*\*\*Note: Software resulting from a CRADA presumes permission to assert copyright. Classification is bypassed and notice of intent to assert is sent to DOE. ESTSC requirements must still be fulfilled.*

# Copyright Assertion Process



*\*Note: The Memo will be held if assurances of satisfying ESTSC requirements are unsatisfactory.*

*\*\*Note: Notification will be not be sent until ESTSC materials are provided.*

# Patenting - Technical Advance (TA)

- A technical advance (TA) is the reporting mechanism by which Sandians communicate with the Legal Department and the DOE about new potential inventions or significant advances.

**TA Index**

Click on the General Information link to fill out the information necessary to generate the rest of the TA form. After clicking the Validate and Save button on the General Information section, you will be returned to this page. At that point, the other section links will be activated so that you can fill out the rest of the TA form.

Section	Status
<a href="#">General Information</a>	Not Started
<a href="#">Originators</a>	Not Started
<a href="#">Funding</a>	Not Started
<a href="#">Important Dates</a>	Not Started
<a href="#">Development</a>	Not Started
<a href="#">Invention Description</a>	Not Started
<a href="#">Technology Transfer</a>	Not Started
<a href="#">Authorized Derivative Classifier</a>	Not Started
<a href="#">Attachments</a>	N/A

# Technical Advance (TA)

- Submitting a TA does NOT provide any legal protection. The TA must be reviewed and selected for a patent filing.
- A TA may be created by the point of contact (POC), who must be an individual who contributed to the invention. As POC, this person will be contacted for questions about the TA. A preparer may create a TA for the POC, but only the POC may submit it. After submittal, an ADC must approve it.
- Sandia's Prime Contract with DOE REQUIRES all employees to report potential inventions (TAs) .

# Technical Advance (TA)

## IP Review

- The TA Review is a monthly/quarterly or “as needed” meeting of representatives from legal, licensing/commercialization, and the technical line.
- It is the decision making body as to if and what patent applications will be filed.

# Technical Advance (TA)

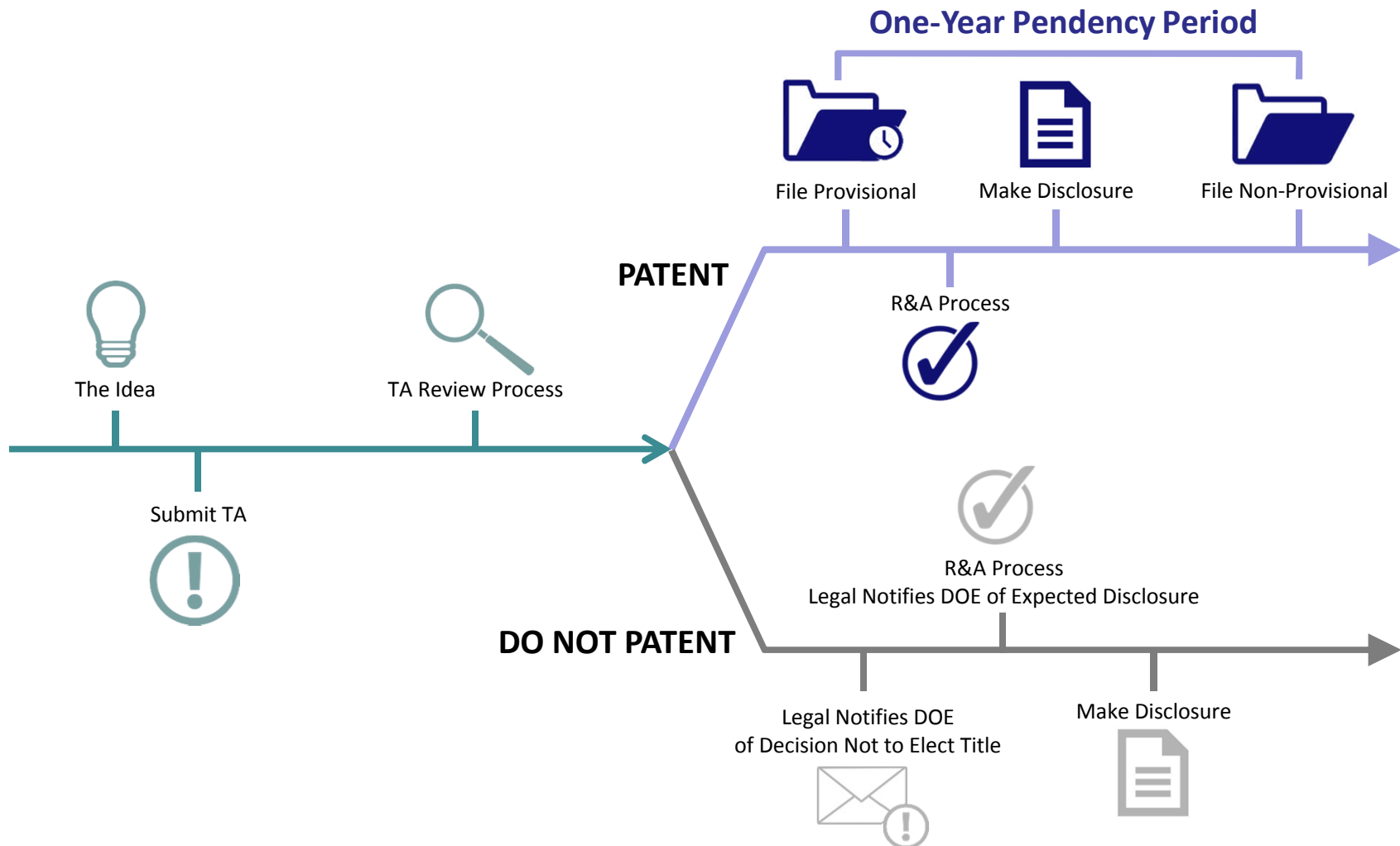
- After a TA is selected for filing in an IP review, a patent attorney will contact the POC to begin the patent process.



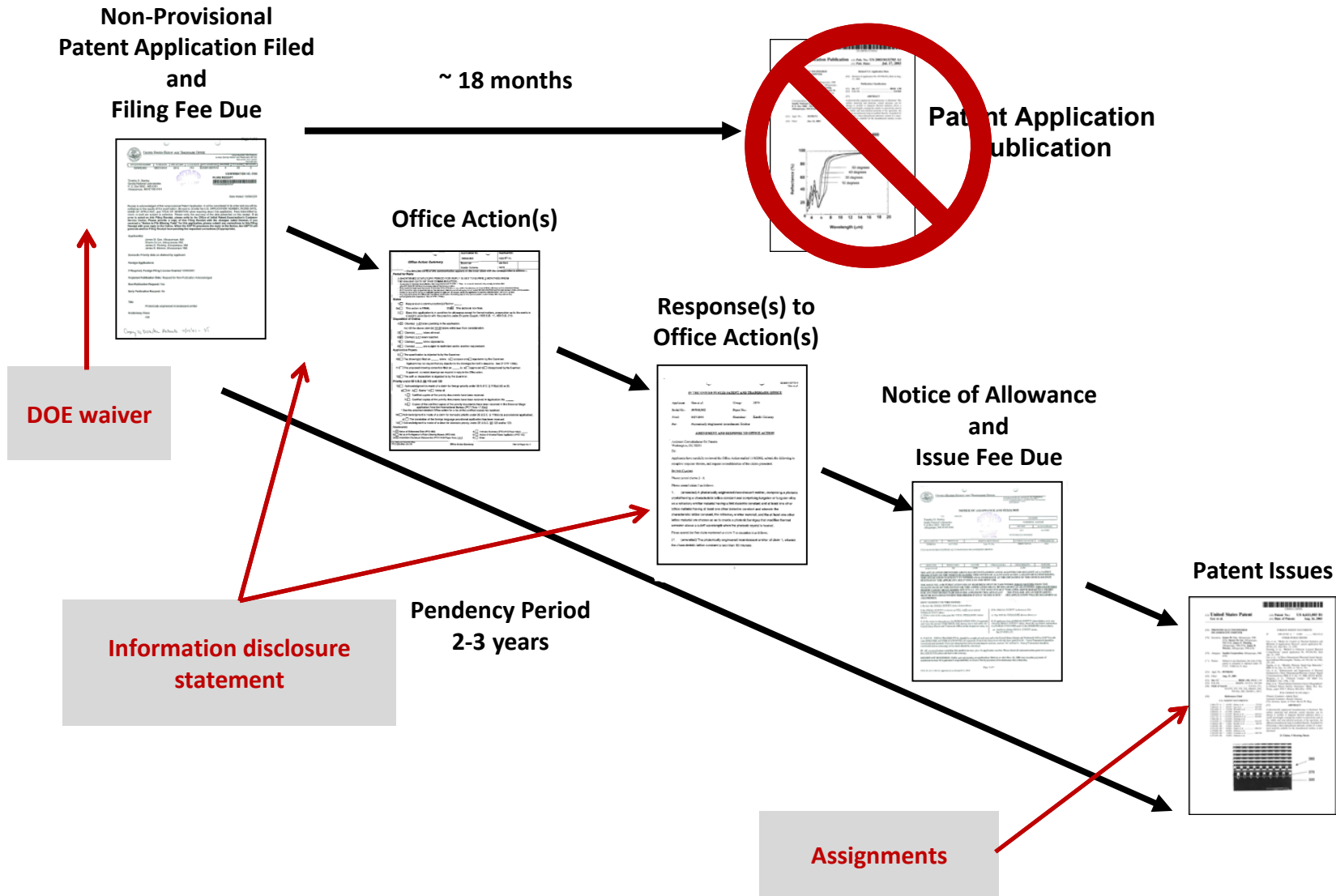
# Patent Process

- The patent process has 4 stages:
  - drafting, filing, examination, and issuance.
- The POC and originators will work closely with an assigned Patent Attorney (in-house or outside law firm) to draft and file the patent application during the first two stages.
  - This can take anywhere from a months to a few months to complete.
- The examination stage takes place with the USPTO or foreign patent office. If issued and the fee paid, the final list of claims will be published along with the issued patent and patent number.
  - The examination and issuance stages typically take 3 years or longer from filing.

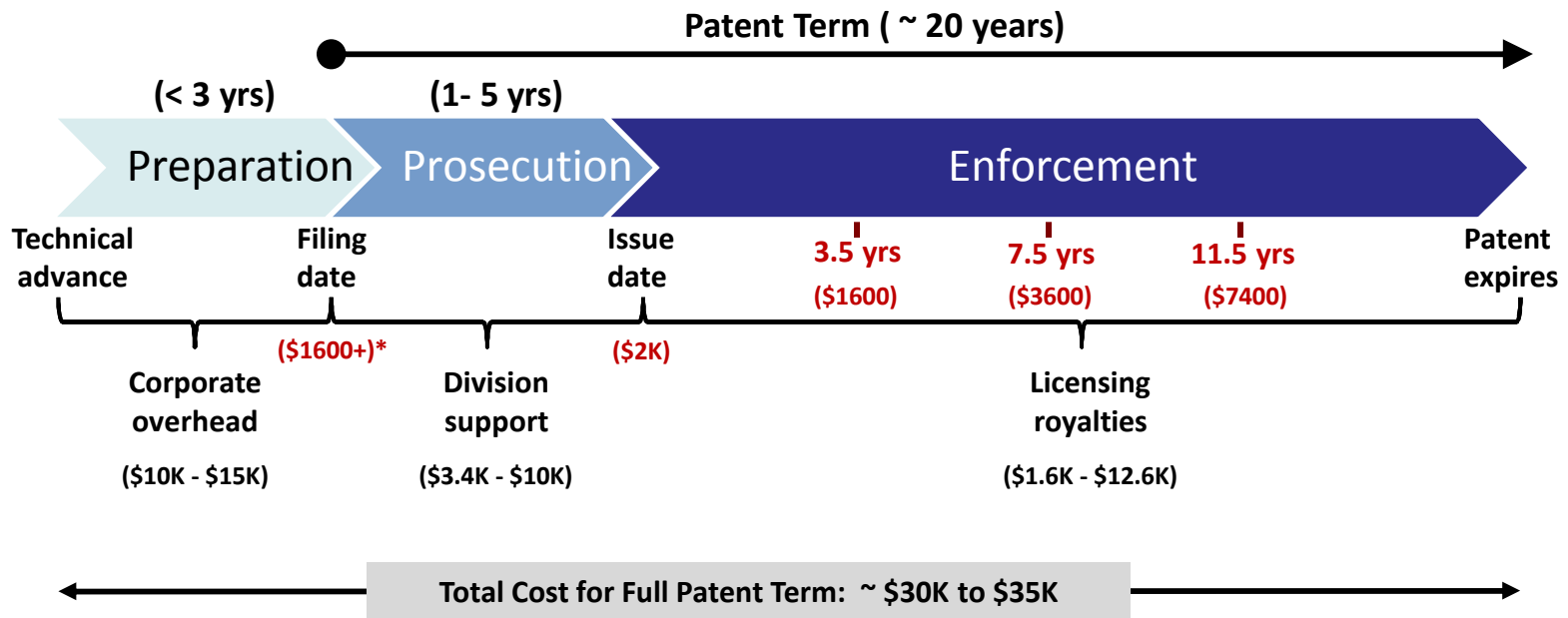
# Technical Advance (TA) to Patent App - A Preferred Timeline -



# U.S. Patent Prosecution

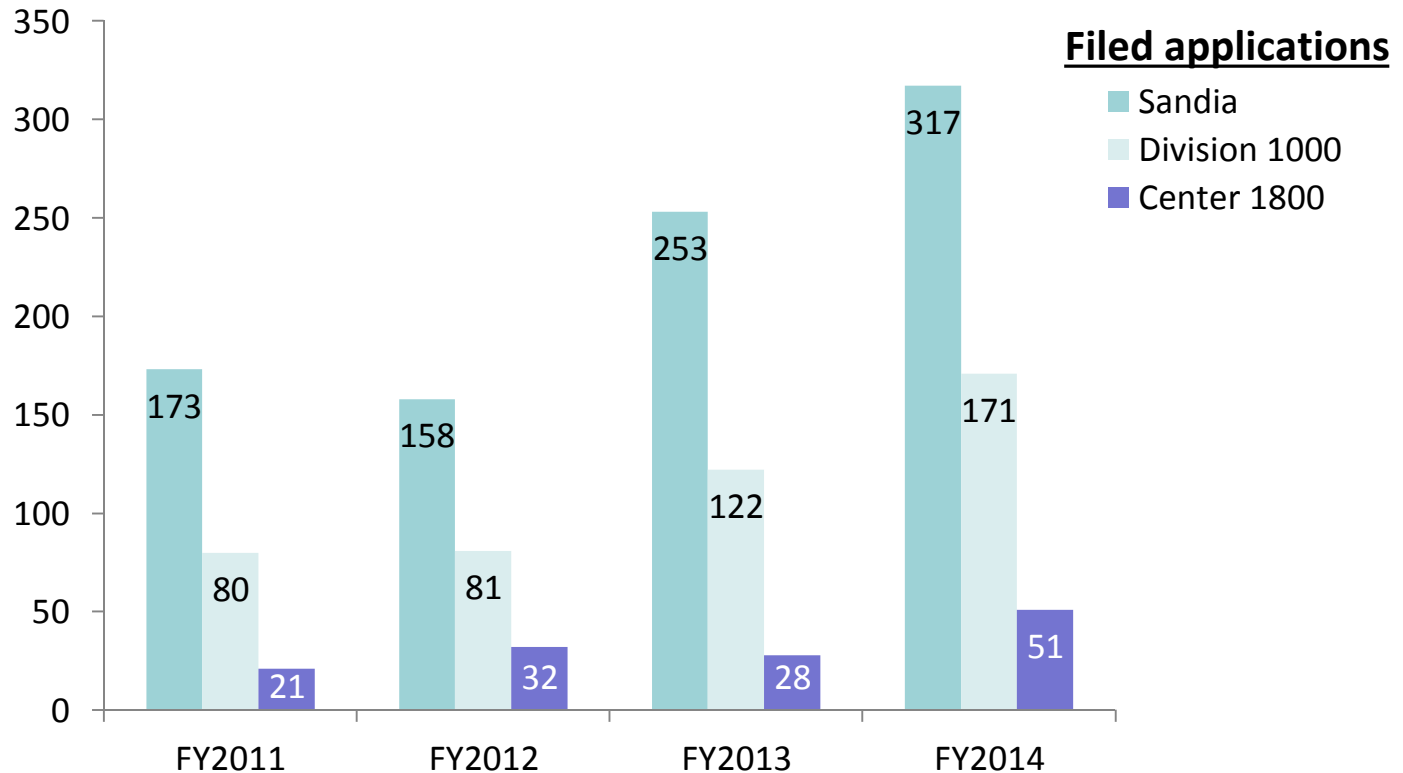


# Patent Life Cycle (US Only)



# Patent Filings: Earlier and More Often

- Overall patent application filing increased ~60% in FY2013, with further increases in FY2014
- Patent applications are filed on about one-half of TAs submitted



# Licensing (patent or copyright)

- The licensing process generally begins with either a specific request from industry, existing partnership (CRADA partner, etc.) or IP that has been selected for marketing within Sandia.



# Licensing Agreements

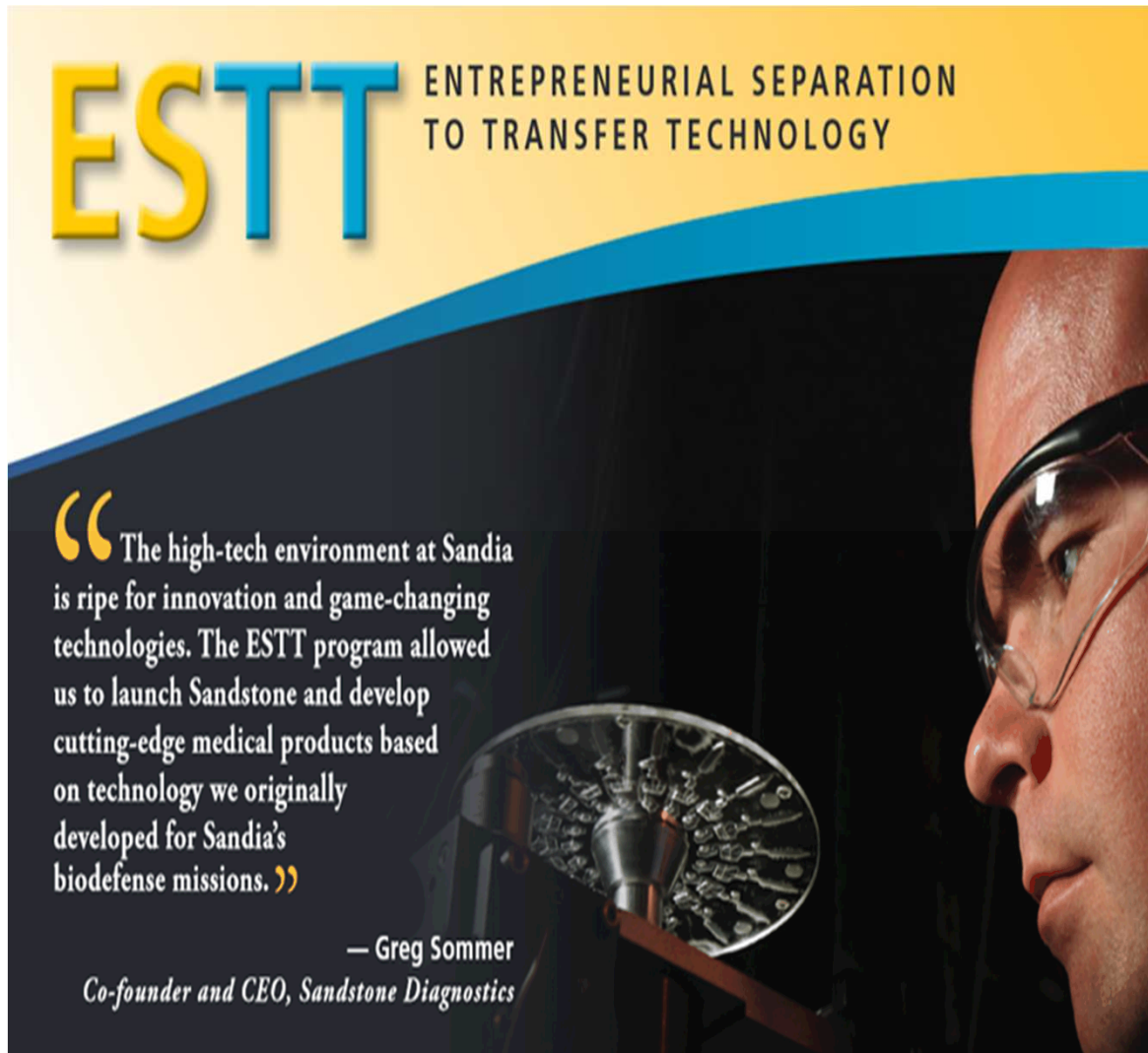
- Commercial License
  - A commercial license gives rights to Sandia IP (in the form of patents, copyrights or trademarks) for instances where the licensee will be using the IP for profit in commercial ventures.
  - Hybrid license is for patents AND copyrights
  
- License Option Agreement (LOA)
  - LOAs are used to grant an option to Sandia IP at set terms and conditions for a Commercial License limited in time.

# Licensing Agreements

- Test and Evaluation or Research License
  - A test and evaluation or research license gives rights to Sandia IP (in the form of patents, copyrights or trademarks) for short term test and evaluation of Sandia technology, or for non-commercial research use (i.e. Universities).
- End User License (EULA) - Copyright
  - A End User License or EULA gives rights to Sandia IP (in the form of copyrights) for instances where the licensee will be using the IP for profit in commercial ventures, or in the end user application or device.

# Entrepreneurial Separation to Transfer Technology (ESTT)

- ESTT is a valuable tool which allows Sandia to transfer technology to the private sector by permitting Sandia employees to leave the Labs to start up new technology companies or help expand existing companies.
- Entrepreneurs are guaranteed reinstatement by Sandia if they choose to return to the Labs.
- ESTT began in 1994



**ESTT** ENTREPRENEURIAL SEPARATION  
TO TRANSFER TECHNOLOGY

“ The high-tech environment at Sandia is ripe for innovation and game-changing technologies. The ESTT program allowed us to launch Sandstone and develop cutting-edge medical products based on technology we originally developed for Sandia’s biodefense missions. ”

— Greg Sommer  
*Co-founder and CEO, Sandstone Diagnostics*

# Questions?

